

REMARKS

Claims 13, 16 and 18-21 are pending. Claims 13, 16, 19 and 2 are amended and claims 1-12, 14, 15, and 17 are canceled without prejudice to or disclaimer of the subject matter found therein.

Entry of the amendments is proper under 37 CFR §1.116 since the amendments: (a) place the application in condition for allowance for the reasons discussed herein; (b) do not raise any new issue requiring further search and/or consideration since the amendments cancel finally withdrawn claims; (c) do not present any additional claims without canceling a corresponding number of finally rejected claims; and (d) place the application in better form for appeal, should an appeal be necessary.

Applicants appreciate the courtesies shown to Applicants' representative by Examiner Lugo in the June 7, 2005 personal interview. Applicants' separate record of the substance of the interview is incorporated into the following remarks.

In Paragraph 2, on page 2 of the Office Action, a Restriction Requirement was made final. Although Applicants believe the Restriction Requirement is improper for all the reasons discussed in the Amendment filed December 16, 2004, in order to expedite prosecution of the application, the withdrawn claims have been canceled.

In Paragraph 5, on page 3 of the Office Action, claims 13 and 16 were rejected under 35 U.S.C. §103(a) being unpatentable over RubberStamps.com (Rubber Stamps) as modified by U.S. Patent No. 6,134,548 to Gottsman et al. (Gottsman), in view of U.S. Patent No. 6,594,642, to Lemchen and further in view of U.S. Patent No. 6,161,099 to Harrington et al. (Harrington). The rejection is respectfully traversed.

Applicants' invention claim 13 calls for an automated method of providing a personalized product in response to each request from customers, the automated method comprising the steps of receiving, by wireless communication, electronic personalized

product producing data in a first format and customer identification information; electronically sequentially storing sets of the personalized product producing data and the customer identification information, each set including a piece of personalized product producing data and a piece of customer identification information; electronically analyzing each piece of electronic personalized product producing data in the first format and converting it to a piece of electronic data in a second format; receiving the piece of data in the second format and recording the piece of data in the second format on an output medium used to produce a personalized product; producing the personalized product; and automatically notifying a customer of at least one of receipt of the electronic personalized product producing data and completion of the personalized product requested, wherein the automated method incorporates the request and producing of the personalized product taking place within a limited, defined geographic area or facility where the customer is located, and delivery of the personalized product will occur. Claim 16 further adds the step of delivering the personalized product produced to a location within the limited, defined geographic area or facility designated by each piece of customer identification information.

As repeatedly noted throughout prosecution of this application, the applied references do no such thing. Further, their combination is improper and does not comply with the provisions of the Manual of Patent Examining Procedures.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. And finally, the prior art reference or references when combined must teach or suggest all the claim limitations. A teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art and not based on

Applicants' disclosure. Further, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination (*In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 Fed. Cir. 1990). Likewise, the statement that something may be within the ordinary skill of the art does not establish a *prima facie* case of obviousness without something to suggest or motivate one skilled in the art to make such a modification and indicate that they would have a reasonable expectation of success if they would do so. The rejection fails on all these counts.

As discussed in the Amendment filed December 16, 2004, Rubber Stamps is solely concerned with an ordering system. The first page states, "Order your rubber stamps ON-LINE NOW interactively. You may also fax your order to us by using your browser's Print command on any of our order form pages from the Order Form Menu." It then has an online order forms menu and provides various means for shipping on page 2. The order form, starting on page 3, covers three pages. Thus, it is clear it is not intended for use with something such as a telephone. Further, there are a number of assumptions made in the Office Action. The material of Rubber Stamps says absolutely nothing about electronically sequentially storing sets of the personalized product producing data. The fact that orders are received by facsimile does not necessarily imply any sequential storing of sets of data as data could be entered by an operator on the operating end as needed. Further, the only way Rubber Stamps can be read as disclosing producing the item is their discussion of taking orders and shipping options. They say nothing specifically in the document about any production methodologies. Thus, Rubber Stamps can only be said to actually disclose orders may be received telephonically as they provide a phone number, by fax as they provide a facsimile number, or online by using a browser's print command and online order forms which may be sent by e-mail.

Further, as acknowledged in the Office Action, Rubber Stamps does not receive the data (communications) by wireless communication, does not electronically analyze each piece of electronic personalized product producing data in the first format and convert it to a piece of electronic data in a second format; does not receive the piece of data in the second format and record the piece of data in the second format on an output medium used to produce a personalized product; and does not automatically notify the customer of completion of the personalized product requested.

Gottzman is applied as teaching use of wireless communication to shop or communicate. However, as noted, Rubber Stamps has a three-page order form and discloses at least three methods of communication to place orders. Thus, where is there a motivation to provide the wireless communication of Gottzman to the system of Rubber Stamps? There is no problem in communicating with Rubber Stamps to order the types of stamps provided. The stamps are essentially business-type stamps, although some, such as address rubber stamps, could be used by a homeowner. This is not the type of item one would order in a mobile environment.

Applicants' environment, however, is a mobile environment where one is attending a recreation area, such as an amusement park, a zoo or similar location, that is, a limited, defined geographic area or facility where everything occurs. What is being ordered is a novelty item or souvenir. As such, ordering is simplified and must consider the mobile environment. As there is no showing of such conditions or problems encountered therein in Rubber Stamps, there is certainly no motivation to combine another method of communication such as found in Gottzman.

Lemchen is alleged to teach having an electronic data analyzer that receives customized data, and converts the data into electronic data that the producing device receives to create a product. That is not what is claimed. In fact, Lemchen teaches a device for

producing products with orders normally going through a middle man, such as a service professional (col. 2, lines 27-39). The request is received through a web server 50 and translated into a set of machine instructions for the particular robotic machine that then produces the item. There is nothing about recording the piece of data in a second format on an output medium used to produce the product. Implicit in such is the second format is readable by an observer. The Lemchen device converts the received order data into production data, i.e., machine instructions for producing the product. There is no intermediate step.

As their own lexicographer, Applicants have defined recording and that is discussed in detail in the December 16, 2004, filed Amendment. Thus, Lemchen does not disclose the features it is alleged to disclose of electronically analyzing each piece of electronic personalized product producing data in the first format and converting it to a piece of electronic data in a second format and receiving the piece of data in the second format and recording the piece of data in the second format on an output medium used to produce a personalized product. Therefore, even if combined with Rubber Stamps, the combination does not suggest the recited features of claim 13.

Lastly, Harrington is applied as teaching automatically notifying the customer of completion of something. The Office Action admits that the base reference, Rubber Stamps, does not disclose such. Harrington discloses a bidding system for auctions conducted on electronic networks. When the bid is submitted, and it becomes the winning bid, there is a notification that the bidder has won the auction. The notification of a winning is the something completed. This does not say that all bidders are notified of the results or suggest notifying a customer whose order has been received or that the customer's product is ready. Applicants' system notifies all parties that contact the system of a given status. Harrington's system notifies the winner of an auction. The majority of participants do not receive

notification of the results of the auction. Further, there is nothing in either reference, that is Rubber Stamps or Harrington, to suggest their combination. Rubber Stamps, by its advertising, states that orders will be received in one to four working days after order or they can use next day air shipping, for an additional cost, so that the customer generally knows when he or she will receive the ordered product. Such being the case, it does not appear there is any suggestion in Rubber Stamps that there is a need to notify customers. Further, as Harrington deals with notifying only winning bidders of an auction, it does not suggest notifying each bidder of the status of the auction and/or who the winning bidder was. Additionally, Harrington has nothing to do with products, i.e., tangible objects as is Applicants' invention. Thus, where is there motivation to go to such disparate art by one developing a product. Therefore, there is no motivation to combine the references.

Lastly, as pointed out in the Amendment filed December 16, 2004, to use this many references from such disparate arts disregards the requirements in the Manual of Patent Examining Procedures that both the claimed invention and the references must be considered as whole and that the references must suggest the desirability, and thus, the obviousness of making the combination. It is unlikely that one making Applicants' invention would have these various references in front of them. Even if one did, for the reasons discussed previously, it is highly unlikely that one would combine them in such a manner to meet all the features of Applicants' claimed invention. The base reference only deals with receiving orders and customer identification. The rest of the features of the claimed invention must be found in the remaining references and it takes three disparate references to find those features. Even so, the features are not precisely found. That being the case, there has been no showing of a *prima facie* case of obviousness as defined in the Manual of Patent Examining Procedures. Thus, it is respectfully requested the rejection be withdrawn and claims 13 and 16 passed to allowance. Claim 16 being allowable for all the reasons discussed above with

respect to claim 13 and for the further features recited in claim 16. That is, claim 16 is directed to delivery of a product to a location designated by the customer. Such is defined in paragraph [0116] of the specification.

In paragraph 6, on page 6 of the Office Action, claim 18 is rejected under 35 U.S.C. §103(a) being unpatentable over Rubber Stamps in view of Gottsman, in view of Lemchen, in view of Harrington and further in view of Arledge et al., U.S. Patent No. 6,535,294 (Arledge). The rejection is respectfully traversed.

As admitted in the Office Action, Rubber Stamps, Gottsman, Lemchen and Harrington or their combination fail to disclose that the system further includes a storage device that stores the personalized product in association with customer information.

Arledge discloses a system for creating printed products. The customer, through the Internet, goes to a retailer's site to order the product. The retailer's site automatically passes the customer to a wholesaler site where the customer actually places an order. Once the order is placed, to include shipping data, which presumably would be directly to the customer, the wholesaler contacts the retailer to make the retailer aware of the order and the fact that the order has been charged to the retailer's account in some manner. The retailer can accept the order, hold the order, or cancel the order. When accepted by the retailer, the wholesaler then prepares the ordered materials and ships the materials in accordance with the shipping instructions provided by the customer. This is all described in the Summary of the Invention from col. 3, line 9 through col. 4, line 41.

Nowhere does Arledge say either the wholesaler, or the retailer, store the produced personalized product in association with the customer information, authenticate each of the customers based on the customer information, and, upon confirmation of the authenticity of each of the customers, provide the stored personal product associated with the customer information to each of the customers. Once the retailer says the order is acceptable, the

wholesaler produces the order and follows the shipping instructions of the customer. In addition to shipping to the customer's residence, the customer could select shipping the order to the chosen retailer or to another address. In any case, there is no discussion of any authentication of the customer when receiving the ordered merchandise (col. 17, lines 30-40). Thus, even if Arledge is added to the other references, which adds but yet another reference, it does not suggest the claimed invention of claim 18. Therefore, it is respectfully requested the rejection be withdrawn.

In paragraph 7, on page 7 of the Office Action, claims 19 and 20 were rejected under 35 U.S.C. §103(a) being unpatentable over Rubber Stamps, in view of Gottsman, Lemchen, Harrington and further in view of Arledge as applied to claims 13 and 18 above, and further in view of Shiota et al., U.S. Patent No. 6,324,521 (Shiota). The rejection is respectfully traversed.

Shiota is directed to printing of photographs. The system has a center server that receives order information and then assigns the laboratory that is to produce the print. Thus, if the order requires special processing it goes to a laboratory capable of performing such processing. If it's just a normal print that all laboratories could produce, then it is determined whether the customer has requested receiving the print over the counter, by mail or other delivery. If the customer has picked mail or other delivery, then any of the laboratories can produce the print. The most effective laboratory, however, is the one that has the high resolution image data so that there is no need to transfer data between laboratories. If the customer chooses to pick up the print or receive it over the counter, then the laboratory requested by the customer produces the print. If the customer does not specify a laboratory, then the production is sent to the laboratory that initially processed the prints as it has the high resolution data (col. 8, line 5 - col. 9, line 40). As such, Shiota does not overcome the

deficiencies of the previous references with respect to claims 13 and 18. Thus, it cannot suggest the subject matter of claim 19.

As to claim 20, Shiota says nothing about a receiver for receiving wireless communication is installed in each of the plurality of locations and is allowed to receive only wireless communications transmitted from the customers within an area associated with each location of the plurality of locations which is a subject matter of claim 20. Thus, the rejection of claim 20 is inappropriate. It is therefore requested the rejection of both claims 19 and 20 be withdrawn.

In paragraph 8, on page 8 of the Office Action, claim 20 (believe claim 21 was meant) was rejected under 35 U.S.C. §103(a) as being unpatentable over Rubber Stamps in view of Gottsman, Lemchen and Harrington as applied to claim 13 above, in further view of Matsunari et al., U.S. Patent No. 5,495,430 (Matsunari). The rejection is respectfully traversed.

Claim 21 is directed to calculating upon receipt of each wireless communication, a number of wireless communications already received and operation conditions of a personalized product producing device, an estimated time of completion of the requested personalized product; and automatically returning a wireless communication including the estimated time of completion to each of the customers. Matsunari discloses no such thing.

Matsunari is a sophisticated workflow estimating process for manufacturing an object, such as a metal die. In the art of such manufacture, prior to Matsunari, the primary method of estimation was to look to experienced operators and supervisors to obtain an estimated production time for a new product. This was then used to set up a production schedule. However, such estimates were found to be subject to considerable error, and the Matsunari invention is an effort to provide a more accurate estimate (col. 1, lines 11-18; col. 2, lines 7-11; col. 2, lines 40-45). Thus, the invention of Matsunari is directed to a process time

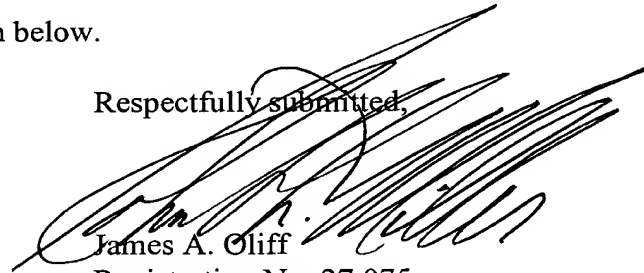
estimating apparatus for accurately estimating the process time based on drawing information for a prescribed product and the corresponding manufacturing steps (col. 3, lines 21-25). As such, it has nothing to do with receipt of a wireless communication, calculating a number of wireless communications already received and the operational condition of the personalized product producing device and then producing an estimated time of completion of the requested personalized product. It also says nothing about automatically returning a wireless communication including the estimated time of completion to each of the customers.

Although Matsunari might discuss a very sophisticated process time estimating apparatus, it has nothing to do with Applicants' claimed invention. How such a sophisticated system would apply to Applicants' invention, as it calculates none of the things Applicants' invention does, is very unclear. To say the concept of estimating a time to do something suggests Applicants' specific requirements is a gigantic leap that is not supported by the Manual of Patent Examining Procedures or the law. Thus, it is respectfully requested the rejection be withdrawn.

Entry of the amendments is thus respectfully requested. In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance of claims 13, 16 and 18-21 are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



James A. Oliff
Registration No. 27,075

Robert A. Miller
Registration No. 32,771

JAO:RAM/kap

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OLIFF & BERRIDGE, PLC
P.O. Box 19928
Alexandria, Virginia 22320
Telephone: (703) 836-6400

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